

REMARKS

The Examiner is thanked for the due consideration given the application. No new matter is believed to be added to the application by this Response.

Claims 1-9 are pending in the present application.

Election/Restriction

The Examiner has restricted the claims of the invention into the following groups:

- I. Claims 2-8, drawn to an oligonucleotide that specifically binds to human tumor necrosis factor alpha (TNF- α) selected from SEQ ID Nos.: 1-28; and
- II. Claim 9, drawn to a method of making SEQ ID Nos.: 1-28.

Applicants elect Group I, claims 2-8 with traverse.

The Examiner has further restricted the invention into the aptamer sequences listed in claims 1-3 that are SEQ ID Nos.: 1-28, noting that up to 10 independent and distinct nucleotide sequences will be examined in a single application.

Applicants elect SEQ ID Nos. 10, 11, 13, 18, 20, 23, 25 and 26 with traverse.

The Examiner additionally restricts claims 1-3 as having unrelated species in a Markush grouping to result in an alleged undue burden on the Examiner.

Applicants traverse.

As set forth in Section 803 of the MPEP, the Examiner must examine an application on the merits if the examination of the entire application can be made without serious burden. Two criteria are identified for proper requirement for restriction:

1. The inventions must be independent or distinct as claimed; and

2. There must be a serious burden on the Examiner if the restriction is not required.

Applicants respectfully submit that a serious burden has not been placed on the Examiner to consider all of the claims in a single application. A review of the subject matter set forth in the claims would have an overlapping search. Thus a different field of search really does not exist with regard to the claims of the present application.

In the Office Action, the Examiner asserts that each sequence is a separate invention. However, the specification points out that the sequences are able to specifically bind to TNF and inhibit the cytotoxicity of TNF- α to L929 cells. That is, all of the sequences have human tumor necrosis factor (TNF- α) inhibiting activity, which is a feature common to those sequences.

Additionally, all of the sequences (SEQ Nos. 1-28) have similar secondary structures. That is, a stem and loop structure is formed by complementary base pairs. Although the secondary structures I-IV are different, all of them are stable stem and loop structures formed by complementary base pairs. The stem and loop structures formed by the complementary base pairs represent another common feature of the sequences. Therefore, all of the sequences have the same activity and secondary structure.

The applicants accordingly respectfully submit that a serious burden has not been placed on the Examiner to consider all of the claims, sequences and Markush groupings in a single application. A review of the subject matter set forth in the claims would have an overlapping search. Thus a different field of search really does not exist with regard to the claims of the present application.

Response to Restriction Requirement filed January 10, 2006
Restriction Requirement dated Nov. 10, 2005

Application No.: 10/822,761
Docket No.: 4533-0108PUS1

Accordingly, rejoinder and examination of all of the claims and species of the invention on the merits is respectfully requested.

Conclusion

If there are any questions regarding this application, the Examiner is respectfully requested to contact Robert E. Goozner, Ph.D. (Reg. No. 42,593) at 703-205-8000.

Pursuant to 37 C.F.R. §§ 1.17 and 1.136(a), Applicant(s) respectfully petition(s) for a one (1) month extension of time for filing a reply in connection with the present application, and the required fee of \$120.00 is attached hereto.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Dated: January 10, 2006

Respectfully submitted,



By 
James M Slattery
Registration No.: 28,380
BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Rd
Suite 100 East
P.O. Box 747
Falls Church, Virginia 22040-0747
(703) 205-8000
Attorney for Applicant